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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,837	03/26/2001	G. Eric Engstrom	112076-138339	9404

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EXAMINER

CASLER, TRACI

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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05/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/817,837	Applicant(s) ENGSTROM, G. ERIC	
	Examiner Traci L. Casler	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 45-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This action is in response to papers filed on February 13, 2008.

Claims 45-71 are pending.

Claim 45, 52, 56, 58 and 64-68 have been amended.

Claims 69-71 have been amended.

Claims 45-71 are rejected.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 64-68 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims as currently claimed simply are directed to software per se. Software is not a statutory subject matter, additionally the computer readable medium could be considered a signal which also does not fall within the statutory subject matter. Applicant is suggested to use the following claim language A computer readable medium tangibly embodied to be read by a computer.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 45-68 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,609,106 Robertson; System and Method for Providing Multi-Merchant Gift Registry Services over a Distributed Network.

1. As to claim 45, 56, 64 and 68 A method of operation, performed by a device, comprising: receiving by the device, from a first server of a first service provider, a request for registration information for a user of the device, the registration information requested including one or more personality characteristics; **Robertson teaches a user being asked(requested) to submit registration information which includes one or more personality characteristics(Fig. 15-16 and C. 9 I. 55-60)**

Generating **dynamically** by the device, or the device causing a second server of a second service provider to **dynamically** provide, **or to provide from a database, a personality profile *having one or more personality characteristics* to portray a desired persona ,*the one or more personality characteristics being based at least in***

*part on a service provided by the first service provider, the second service provider providing a personality service; and Robertson teaches the user(user computer) selecting the user registration and submitting information to a part of the user profile(Fig. 21) **Robert son teaches a peronsality profile being provided by base the characteristics of the profile based at least in part on the service provided by the first service provider(C. 10 I. 38-40). The user registers their wish list of multiple items from multiple merchants in a single centralized location(database).*** The unique ID's(profiles) are used to add items to their wish list. Therefore, the profile is provided by a database of personality characteristics(items).

transmitting by the device, or the device causing the second server to transmit, *the personality profile to the first server to respond to the request. Robertson teaches the user (user computer/device) submitting registration/profile information to the first server.*

3. As to claim 46, 66 and 70 Robertson teaches the user(device) requesting information from the first server(Fig. 15 Ref 265 Fig. 30).

4. As to claims 47-48 Robertson teaches the first service provider providing the profile. The claims do not carry any patentable weight as they fail to further limit independent claim. *Milton v. National Association of Securities* 67 USPQ2d 1614 (CAFC 2003) the courts stated that whereby(wherein) clauses in a method claim is not given patentable weight when it simply expresses the intended. The terms of the claims were not ignored but analyzed in each instance to determine impact. Since examiner is reading the independent claim to be generating the personality profile by the device not

the second server these limitations Which is in the alternative the second server hold no patentable weight.

5. As to claim 49 and 68 Robertson teaches the profile transmitted to the first server(Fig. 16 Ref. 295)

As to claim 50 and 67 Robertson teaches the characteristics as interests and biographical data(Fig. 16 and 17).

6. As to claim 52 A method of operation, performed by a first server of a first service provider providing a personality service, comprising;

7. receiving by the first server, from a client device, a request to dynamically provide **or to provide from a database** a personality profile **having one or more personality characteristics** for a user of the client device, **Robertson teaches the user selecting to register for a server to create a profile, (Fig. 16)** (Fig. 16) for responding to a request of a second server of a second service provider, **The profile is able to be used to supply marketing information to Service providers(C. 3 I. 55-57).**

8. requesting for registration information for the user, the registration information requested including one or more personality characteristics; **Robertson teaches the user registering personal information such as name address phone and special events.(C. 9 I. 55-60).**

9. providing by the first server, a personality profile for response, based at least in part on a service provided by the second service provider; and **(Robertson teaches the profile created based on a SP merchants based on user profile interests(C. 10 I. 14-16)**

10. transmitting by the first server to the client device or the second server the generated personality profile to the second server of the second service provider. **Robertson teaches transmitting the profile to the user computer(Fig. 17 and Fig. 21).**

11. As to claim 53 Robertson teaches receiving personality characteristics(Fig. 23).

12. As to claim 54 Robertson teaches identifying(ascertaining) the services(type of business) of the second service provider based on communication between second server and first server(SP registration) Fig. 24 and 29).

13. As to claim 55 Robertson teaches identifying several people to purchase gifts for and the user selecting one(Fig. 32-33).

14. As to claim 56 Robertson teaches generating at least one profile(C. 10 I. 14-16).

15. As to claim 57 Robertson teaches the personality characteristics as hobbies interests biographical data(Fig28 Fig. 16-17).

Response to Arguments

2. Applicant's arguments filed February 13, 2008 have been fully considered but they are not persuasive.

3. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

5. In applicants arguments they simply state the claim language and that prior art fails to teach it. However, applicant fails to distinguish how the claim language is different or distinct from the prior art.

6. The applicant argues that the personality characteristics are In part based on the service provided. The examiner notes that the users in Robertsons "register" items for their wish list(using unique ID) these items are items that are sold through the online service. The examiner notes the limitation of "based at least in part on a service provided by a service provider" is broad and could be interpreted =[as the user entering their email address which the service provider uses to contact the user, hence their service is a communication with the user and the characteristic based on this service is the email address. As an email address is a characteristic that is personal to that user.

7. As to applicants arguments that Claims 47-48 and 54 do carry patentable weight, the examiner stresses that these claims are directed towards the "second service provider" which is claimed in the alternative in the independent claim. The examiner

has not used the "second service provider" alternative for creating the profile, therefore these claims hold no patentable weight as this alternative is no the portion the examiner has interpreted.

8. Additional, if given patentable weight, Robertson's registry system passed the unique ID onto the service providers for the users to add to their wish list, this would read on the claims if not written in the alternative.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629